

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Rich Baranski

Serial No.: 10/055,757

Filed: January 22, 2002

Title: Adjustable Door Guide Latch Slot Assembly

Examiner: Lugo, Carlos

Group Art Unit: 3676

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed in reply to the Examiner's Answer, mailed on April 17, 2008, in an appeal from the decision dated May 12, 2006 finally rejecting claims 1-10, 14-17 and 22 under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 3,976,317 issued to Collier ("Collier") in view of U.S. Patent No. 2,124,970 issued to Bagley ("Bagley") and finally rejecting claims 11-13 and 18-21 under 35 U.S.C. § 103(a) as being unpatentable over Collier in view of Bagley and further in view of U.S. Patent No. 5,757,269 issued to Roth, et al. ("Roth").

ARGUMENT

1. The Subject Matter of Claims 1-10, 14-17, and 22 Is Not Obvious Under 35 U.S.C § 103(a) Over Collier in View of Bagley¹

In the Examiner's Answer, he maintains the rejection of claims 1-10, 14-17 and 22 as being obvious over Collier in view of Bagley. In support of this rejection, the Examiner presents several arguments for the first time. These newly presented arguments, however, are insufficient to establish obviousness.

a. Collier Does Not Disclose the Recited Door Guide of the Claims

In the Answer, the Examiner concludes Collier discloses a door guide that is adapted to slidably retain a door therein. Examiner's Answer at 6. Specifically, the Examiner argues that the recitation of a door guide "adapted to" retain a door therein such that the door can move slidably along a length of the guide when the door is retained in the guide includes functional language that "does not constitute a limitation in any patentable sense." *Id.* Applicant respectfully disagrees.

The Court of Appeals for the Federal Circuit has acknowledged that the features of an apparatus may be recited either structurally or functionally. *See In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). "[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims." 128 F.3d at 1478 (citing *In re Swinehart*, 58 C.C.P.A. 1027, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971)).

When a claim feature is recited functionally rather than structurally, the prior art can anticipate the claim only if it expressly or inherently includes that feature. *See* 128 F.3d at 1478. In the present case, however, Collier neither expressly nor inherently includes a door guide adapted to retain a door therein such that the door can move slidably along a length of the guide when the door is retained in the guide.

Indeed, the Examiner previously conceded that Collier does not disclose such a door guide. For example, in the Office Action of September 30, 2005, the Examiner conceded that:

¹ Claims 1, 14 and 22 are independent claims. Claims 2-10 depend, either directly or indirectly, from claim 1. Claims 15-17 depend, either directly or indirectly, from claim 14.

Collier fails to disclose that the door guide is adapted to retain the door such that the door can move slidably along the door guide when the door is retained. Collier discloses that the door guide retain the door, however the door will not slide along the door guide because the door used in the device described in Collier is a sliding door, not a rolling door.

Id. at 3.

At page 3 of the Answer, the Examiner reiterates that Collier does not disclose such a door guide. At page 6, however, the Examiner takes a contradictory position - the Examiner now suggests that Collier discloses a guide that is capable of retaining a door slidably therein because the door can move in and out of the guide when it is unlatched. Applicant respectfully submits, however, that this does not constitute movement “slidably along a length of the guide when the door is retained in the guide” as recited in the claims. As discussed in Applicant’s Appeal Brief, the Collier door is retained in the vertical channel of the jamb structure 16 only when the door is in the latched position. In that latched position, however, the door cannot move slidably within that vertical channel. The Examiner has previously conceded as much. Even if the Collier door movement were considered slidable movement, it is not along the length of the vertical channel (*i.e.*, up and down).

Thus, contrary to the Examiner’s new argument, Collier does not disclose a “door guide adapted to retain a door therein such that the door can move slidably along a length of the guide when the door is retained in the guide,” as recited in claims 1-10 and 14-17, or a “door guide having a channel sized to retain a door guide slidably therein,” as recited in claim 22.

b. There Is No Suggestion or Motivation to Combine Collier and Bagley

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) when relying on combined references, the Examiner must identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. MPEP § 2143. The reason must have some rational underpinning to support the legal conclusion of obviousness. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). One way to establish obviousness is to identify some suggestion or motivation to modify the reference to produce the claimed invention. *See* MPEP § 2142. In performing this analysis, however, the “factfinder should be aware . . . of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.

Ct. 1727, 82 USPQ2d at 1397. *See also Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474.

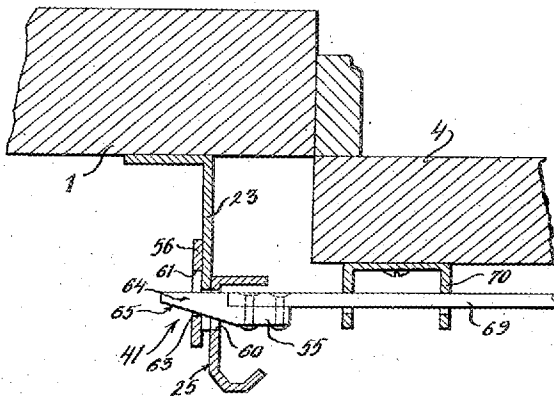
Rejections based on obviousness cannot be sustained with mere conclusory statements. *Id.* § 2142. Moreover, conclusions of obviousness based on “common knowledge” and “common sense” are not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *See* MPEP § 2143.01 (Assertion that modifications of the prior art would have been “well within the ordinary skill of the art at the time the claimed invention was made” is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.) Applicants respectfully submit, therefore, that the Examiner has failed to establish a *prima facie* case of obviousness.

In the Answer, the Examiner asserts that the latch mechanisms of Collier and Bagley “are essentially the same in structure” and that the type of door used “is a design consideration within the art since it would not affect the function of the door guide and the function of the latch.” Examiner’s Answer at 7. Applicant respectfully suggests that the Examiner’s assertion does not present a sufficient rationale to find obviousness.

First, even if the Collier strike plate could be modified for use on the garage door of Bagley, that is not enough to show obviousness. “The mere fact that the prior art could be modified in the manner proposed by the Examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *Ex parte Dussaud*, 7 USPQ2d 1818, 1820 (Bd. App. & Int’f 1988); *see* MPEP § 2143.01. In this case, nothing in the prior art suggests the desirability of the asserted combination. On the contrary, the cited overhead door art teaches away from such a combination. As shown in Bagley, the accepted location of a strike plate for an overhead door is on the outside of the guide track, not on the inside. This can be seen clearly in FIG. 8 of Bagley, which is shown below, wherein the strike plate 56 is on the outside of the guide track 25.²

² In the Answer, the Examiner apparently asserts that the guide track is located in the area of FIG. 8 where the callout number 23 is located. *See* Examiner’s Answer, attachment #2 (showing a wheel in this area). This is incorrect. As set forth in the Bagley specification, the roller track is designated by callout number 25.

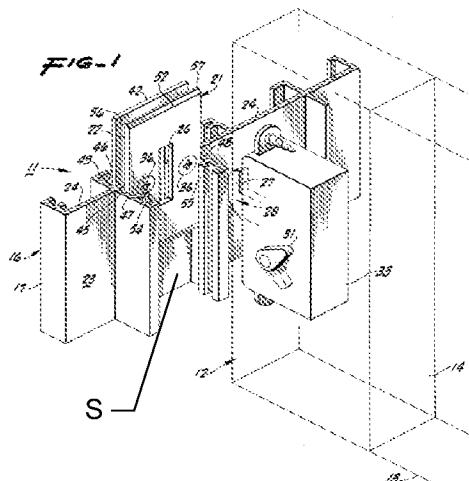
Fig. 8.



Moreover, the Examiner's assertion ignores the different issues associated with a latch for an overhead door (like Bagley) versus one located in a jamb for a vertical sliding door (as in Collier). For example, a latch mechanism for an overhead door must not interfere with the operation of the door rollers. This is not a concern with a sliding door latch mechanism, which is mounted in the door jamb.

Finally, and perhaps most tellingly, the Examiner's assertion that using the Collier jamb structure on the Bagley door guide would not affect the function of the Bagley overhead door is incorrect. As discussed above, the latch mechanism for an overhead door must not interfere with the operation of the door rollers. If the Collier jamb structure 16 and plate 21 were to be used with the Bagley overhead door, however, the plate would block the operation of the overhead door rollers and thereby affect the functioning of the overhead door.

This can be seen by referring to FIG. 1 of Collier, which is shown below for convenience.



As shown in FIG. 1, Collier discloses a lock jamb structure 16 that defines a vertical channel between flanges 47, 48. The inner surface S of this channel is flat and does not include a recess. Thus, when the striker plate 21 is positioned in the vertical channel, the plate 21 is not flush with the inner surface S but instead is raised with respect to the surface S. If such a vertical channel structure were used as a roller track for an overhead door, the raised plate 21 would interfere with the overhead door roller and thereby affect the functioning of the door.

c. Collier and Bagley Do Not Disclose the Limitations of Claims 2, 3, 14 and 15

Claims 2, 3, 14 and 15 recite “a recessed area on said door guide inner surface.” Claims 2 and 3 further recite that the recessed area is large enough so that the striker plate can be placed flat within it. Claims 14 and 15 recite that the striker plate can be placed flat against the door guide inner surface in the recessed area. Even if it were proper to combine Collier and Bagley, that combination does not teach or suggest these recited limitations and does not render the claims obvious.

The Examiner does not dispute that the inner surface of the door guide of Bagley does not include a recess. In the Answer, however, the Examiner contends that Collier discloses a recessed area on a door guide inner surface. Examiner’s Answer at 4. Applicant respectfully disagrees.

In support of his conclusion, the Examiner points to the Collier door jamb inner surface against which the striker plate is positioned. *See* Examiner’s Answer, attachment #3. As shown above in FIG. 1 of Collier (see above), however, the inner surface S of the jamb structure does not include a recess. Consequently, as previously discussed, when the striker plate 21 is positioned in the vertical channel of the jamb structure 16, the plate 21 is not flush with the inner surface S but instead is raised. Thus, the plate would block the operation of overhead door rollers operating within the vertical channel.

Applicant respectfully submits, therefore, that claims 1-10, 14-17 and 22 are patentable over the proposed combination of Collier and Bagley.

2. The Subject Matter of Claims 11-13 and 18-21 is Not Obvious Under 35 U.S.C § 103(a) Over Collier in View of Bagley, and Further in View of Roth³

In the Answer, the Examiner maintains the rejection of claims 11-13 and 18-21 as being obvious under 35 U.S.C. § 103(a) over Collier in view of Bagley and further in view of Roth. Applicant respectfully submits, however, that the Examiner has failed to provide a sufficient rationale for combining all of the cited references. In any event, the combination of Collier, Bagley and Roth does not teach all of the limitations of the claims.

In contrast to Applicants' claims, Roth discloses a closure latch or bolt monitoring device mountable in a door jamb. Nothing in Roth suggests the desirability of locating the strike plate in a guide within which a door slides.

With the Answer, the Examiner has provided three patent references to support his contention that it is well known to provide "securing devices" with a latch member on a door. *See* Examiner's Answer at 7. Be that as it may, for the reasons discussed above, Applicant submits that the Examiner has failed to present a sufficient rationale to combine Collier with Bagley and has therefore failed to present such a rationale to combine all of Collier, Bagley and Roth.

In any event, whether or not it is well known to provide a security device with a door latch member, the combination of Collier, Bagley and Roth fails to teach all of the limitations of the claims. Claims 11-13 and 18 depend from and include all of the limitations of claim 1 or claim 14. As discussed above, the cited art does not teach all of the limitations of those claims.

Claim 19-21 also include a "door guide adapted to retain a door therein such that the door can move slidably along a length of the guide when the door is retained in the guide" and a striker plate that "may be placed flat against said door guide inner surface within said recessed area and may be adjustably affixed to said door guide inner surface so that said striker plate latch opening aligns with said slidable door latch." Again, as discussed above, the combination of Collier and Bagly does not teach these limitations. Roth does not cure this defect.

Applicant respectfully submits, therefore, that claims 11-13 and 18-21 are patentable over the proposed combination of Collier, Bagley and Roth.

³ Claim 19 is an independent claim. Claims 11-13 depend, either directly or indirectly from claim 1. Claim 18 depends indirectly from claim 14. Claims 20-21 depend, either directly or indirectly from claim 19.

CONCLUSION

Based on the foregoing, it is respectfully requested that the rejection of claims 1-22 be withdrawn and that the claims be allowed.

Dated: June 17, 2008

Respectfully submitted,

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